



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Ian B. Maclean § Art Unit: 2665
Serial No.: 09/775,238 §
Filed: February 1, 2001 § Examiner: Daniel J. Ryman
For: Communicating Between Nodes § Atty. Dkt. No.: NRT.0090US
in Different Wireless Networks § (13366RRUS02U)

Mail Stop AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

CLAIM 4

Independent claim 4 was rejected as being obvious over the asserted combination of Inoue, Leung, and Rao. It is respectfully submitted that a *prima facie* case of obviousness has not been established with respect to claim 4 over these references, as no motivation or suggestion existed to combine their teachings. *See MPEP § 2143 (8th ed., Rev. 3), at 2100-135.*

The Office Action conceded that Inoue does not disclose receiving a first IP packet having a payload portion containing a GTP data unit, where the IP packet has a header containing a private network address of a first node in the first wireless network, and the GTP data unit in the payload portion of the IP packet contains the private network address of the first node. 3/8/2006 Office Action at 5. However, the Office Action relied upon Leung as disclosing GTP. *Id.* at 5-6.

Date of Deposit: May 30, 2006

I hereby certify under 37 CFR 1.8(a) that this correspondence is being deposited with the United States Postal Service as **first class mail** with sufficient postage on the date indicated above and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313.

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The Office Action further conceded that Inoue in view of Leung does not disclose translating the private network address in each of the header and payload portion to a public network address. *Id.* at 6. Instead, the Office Action relied upon Rao as disclosing this feature. *Id.*

As purportedly supporting the obviousness rejections, the Office Action cited *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). However, the Office Action has failed to follow the guidance provided by this case. The court in *In re Fine* held that “(t)he PTO has the burden under section 103 to establish a *prima facie* case of obviousness.” *In re Fine*, 837 F.2d at 1074. In fact, the PTO “can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would have lead that individual to combine the relevant teachings of the references.” *Id.* Here, what the Office Action has apparently engaged in is simply citing to three different references as teaching three separate elements of claim 4, and then stating that because these references disclose such isolated claim elements, that claim 4 would have been obvious. It is respectfully submitted that this analysis is erroneous.

In fact, the references cited by the Office Action establish that the claimed subject matter is *non-obvious* over Inoue, Leung, and Rao. Inoue describes conventional address translation in which the source and destination addresses in only a *header* of a packet are translated. See Inoue, 9:51-57; 1:32-33. Inoue does not provide any suggestion of any desirability to embed a private network address into a payload portion of a data packet, or to translate the private network address contained in the payload portion of the data packet. It is important to note that at least as of the filing date of Inoue, a person of ordinary skill in the art did not recognize that network address translation of addresses in both the header and payload portion of a packet within wireless networks is desirable.

The second reference cited by the Office Action, Leung, also refers to network address translation as well as the use of GTP in a GPRS wireless network. Although Leung refers to both GTP and network address translation, Leung fails to recognize that there was any need for performing network address translation of an address in both the header and payload portion of a packet. In the present application, one of the motivating factors that led to the development of some embodiments of the invention was that, when GTP is used to tunnel data through an interface between support nodes, the network address translator, according to some

embodiments, performs translation of both the header and payload portion of a packet. Specification, page 7, line 19-page 8, line 4. This issue was clearly not recognized by Leung even though it taught the use of GTP and network address translation.

In fact, Leung is assigned to the same assignee as Rao (Cisco). Even though Rao, which is directed to a traditional wired network environment, refers to network address translation of addresses in an IP header and payload, there was no indication by Rao that such techniques would be desirable in a wireless environment. Leung is objective evidence that, even within the same company, persons of ordinary skill in the art did not recognize that the techniques of Rao can be applied to Leung.

Thus, Inoue and Leung provide objective evidence that persons of ordinary skill in the art did not recognize any desirability to perform network address translation of both the header and payload in a packet in wireless networks.

In view of the foregoing, it is respectfully submitted that a *prima facie* case of obviousness has clearly not been established with respect to claim 4 over Inoue, Leung, and Rao.

CLAIMS 3 AND 10

Independent claims 3 and 10 were rejected as being obvious over Inoue and Rao. It is respectfully submitted that a *prima facie* case of obviousness has not been established with respect to either claim 3 or claim 10 for at least the reason that no motivation or suggestion existed to combine the teachings of Inoue and Rao. As explained above, the objective evidence of record establishes that a person of ordinary skill in the art would not have been motivated to combine the teachings of Inoue and Rao. Inoue describes conventional address translation in which the source and destination addresses in only a header portion of a packet are translated. Absolutely no mention is made in Inoue of any desirability to perform translation of an address contained in the payload portion of the data network within a wireless environment. There existed no suggestion by Rao or by any other evidence of record that it would have been desirable to apply the teachings of Rao to modify the Inoue system.

Therefore, claims 3 and 10 are clearly allowable over Inoue and Rao.

CLAIMS 5, 18, AND 25

Each of independent claims 5, 18, and 25 were rejected as being obvious over Inoue, Rao, and Chuah. Again, a *prima facie* case of obviousness has not been established since there existed no motivation or suggestion to combine the teachings of these references. The Office Action conceded that Inoue and Rao do not disclose GPRS support nodes. 3/8/2006 Office Action at 7. However, the Office Action relied upon Chuah as disclosing GPRS support nodes.

Rather than support the obviousness rejection, it is respectfully submitted that Chuah (like Leung) also provides objective evidence that a person of ordinary skill in the art did not recognize that translation of addresses in headers and payload portions would be desirable in a wireless environment. Chuah also teaches the use of GTP for communicating data in a wireless communications network. However, nowhere within Chuah is there any suggestion that network address translation of both a header and payload portion of a packet would be desirable.

Therefore, it is respectfully submitted that claims 5, 18, and 25 are allowable over Inoue, Rao, and Chuah.

DEPENDENT CLAIMS

Dependent claims are allowable for at least the same reasons as corresponding independent claims. Moreover, in view of the allowance of base claims over corresponding combinations of references, it is respectfully submitted that the obviousness rejections of the dependent claims have also been overcome.

In view of the foregoing, it is respectfully requested that the final rejections of the claims be withdrawn. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 20-1504 (NRT.0090US).

Respectfully submitted,

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